

REMARKS

Reconsideration of this application and the rejection of claims 1-19 is respectfully requested. Applicants have attempted to address every objection and ground of rejection in the Office Action dated September 12, 2003 (Paper No. 4) and believe the application is now in condition for allowance. The claims have been amended to more clearly describe the present invention.

As a preliminary matter, in response to the restriction requirement, Applicants have formally elected Group I, claims 1-19 without traverse. Group I is drawn to a hand-held massager. Claims 20 and 21 have been canceled, and amended and rewritten in dependent form as new claims 22 and 23 to depend from claim 1. Applicants submit that the inclusion of these claims is proper, in that dependent claims 16 and 17 which also relate to the pump were retained by the Examiner in Group I.

Further, regarding the Information Disclosure Statement filed July 28, 2003, which was cited to be deficient for lacking an explanation of the relevance of the non-English references, a copy of the relevant UK Search Report stating the relevance of the references accompanied the Statement. Consequently, pursuant to MPEP 609 III A(3), the non-English references should have been considered by the Examiner. Confirmation of their consideration is requested.

Claims 1-4, 6, 11, 12 and 13 stand rejected under 35 U.S.C § 102 (b) as being anticipated by German Patent 3,905,517 ("the '517 patent"). The '517 patent teaches a device for applying liquid to the skin by a ball applicator (1) which is to be rolled over the

skin. The ball applicator is embedded in a bearing (9) and can be humidified via a tank (4) in the bearing. Further, the ball applicator is heated via hot plates (2), vibrated via a motor (3) and electrified via a contact (5).

It is clear from the drawing that the humidified tank (4) supplies liquid to the ball applicator within the bearing (9) and coats the ball applicator. When rolled over the body, the coated ball applicator applies liquid to the skin. Moreover, liquid is released on to the peripheral of the ball applicator from within the bearing and must circulate within the bearing until being disposed on the skin. Thus, liquid never enters the ball applicator or any part of the body-contacting structure, consequently resulting in some liquid remaining trapped within the bearing surface.

In contrast, amended claim 1, now recites, among other things, a hand-held massager, comprising a housing having a gripping portion and a body-contacting portion, said housing being configured for emitting a massaging liquid and said body-contacting portion including a heated applicator pad which is generally planar and fixed to said body-contacting portion, said body-contacting portion being configured for emitting heat directly to a target body surface and said housing being configured so that the massaging liquid is emitted from said body-contacting portion so that the heat is applied by said body-contacting portion to the target body surface and to the emitted liquid.

Claim 1 has been amended by incorporating features of canceled claim 2, among other things, and is supported in the paragraph beginning on page 7, line 16 and FIGs. 1-4. Thus, unlike the '517 patent, the body-contacting portion, as recited in the

presently claimed massager, provides a direct route for the massaging liquid to reach the skin. Moreover, the feature of the body-contacting portion emitting massaging liquid provides efficient application with less massaging liquid being wasted. Since the structure now claimed in the present massager is clearly not disclosed by the '517 patent, the 35 U.S.C § 102 (b) rejection based on the '517 patent should be withdrawn and claim 1 is submitted to be allowable.

Further, regarding claim 11, the Examiner cites the '517 patent as teaching a pocket (9) and at least one massaging enhancement pad (2). Though the Examiner cites the '517 patent's bearing as a "pocket" with the hot plates serving as an "enhancement pad", the '517 patent still does not anticipate the massager as now claimed. Claim 11 of the present invention recites, among other things, a pocket "on said body-contacting portion of said housing". The '517 patent fails to disclose this structure. In contrast, the '517 patent teaches the heat plates being located within the bearing of the housing, not on the applicator ball. In fact, according to the '517 patent, the heat plates never contact the skin.

Claims 5 and 7-9 stand rejected under 35 U.S.C § 103(a) as being obvious in view of the combination of the '517 patent and Kiefer et al. The arguments asserted above traversing the rejection of claim 1 under 35 U.S.C § 102(b) are reasserted here. Claims 5 and 7-9 ultimately depend from claim 1 and thus include features not disclosed or suggested by the '517 patent.

Further, Kiefer teaches an electro facial therapeutic device having an elongated main body with a long handle at one end and an opposite end having a bowl

shaped aluminum plate with an electric coil behind the bowl connected to a transformer for heating up the bowl surface. A reservoir is located on the rear side of the main body on the opposite side from the aluminum plate.

In contrast to the present massager, Kiefer teaches that massaging liquid or cream is dispensed from the rear side of the main body, on the opposite side from the heated bowl surface. Moreover, though the Examiner cites Kiefer as teaching a way to control temperature and vibration, neither reference, whether taken alone or in combination, discloses or suggests the now claimed massager. As amended, claim 1, recites, among other things, massaging fluid emitted from said body-contacting portion. Neither the '517 patent nor Kiefer discloses or suggests this feature. Thus, as now recited, Applicants' massager cannot be deduced by one skilled in the art when neither of the references before him teach this claimed feature. Therefore, the rejection based on the combination of the '517 patent and Kiefer is respectfully traversed. Accordingly, claims 5 and 7-9 are submitted to be allowable.

Claim 10 stands rejected under 35 U.S.C § 103(a) as being obvious in view of the '517 patent and Kiefer et al. and in further view of Cheng '159. Claim 10 ultimately depends from claim 1 and thus includes features neither disclosed nor suggested by the '517 patent. The arguments asserted above traversing the rejection based on the '517 patent and Kiefer et al. are reasserted here.

Cheng teaches using rubber bolts to connect the massaging devices to the casing "so that the massaging devices can be vibrated for rubbing and kneading the muscles

and joints effectively” (Column 1, lines 31-33). Rather than “isolating the gripping portion from the body-contacting portion” as the Examiner recites, the rubber bolts as taught by Cheng act to secure the vibrating plate (21) to the casing (1). Nowhere does Cheng teach that the vibrating plate is used to isolate vibrations from the casing to the handle.

In the presently claimed massager, the gasket seals the seam between the gripping portion 14 and the body-contacting portion 16, partially isolating the body-contacting portion by dampening vibrations generated by the motor. In effect, the gasket acts as a resilient barrier between the two housing portions. Unlike the rubber bolts as taught by Cheng, the gasket does not function to provide any clamping force to hold the gripping portion and the body contacting portion together. Consequently, the rubber bolts as taught by Cheng and the gasket of the presently claimed massager do not even accomplish the same task. Further, the Examiner provides no explanation as to how to modify the ‘517 patent with rubber bolts as taught by Cheng, considering the rubber bolts were used as a securing mechanism between the vibrating plate and the casing, not between the motor and the casing. Thus, as now recited, Applicants’ massager cannot be deduced by one skilled in the art when neither of the references before him teach the gasket's claimed feature. Therefore, the rejection based on the combination of the ‘517 patent and Kiefer in further view of Cheng is respectfully traversed and accordingly, claim 10 is submitted to be allowable.

Claims 14 and 15 stand rejected under 35 U.S.C § 103(a) as being obvious over McGrath in view of Kiefer et al. The arguments asserted above traversing the rejection

based on Kiefer are reasserted here. McGrath teaches a fluid dispensing vibrator having a hand-held housing containing a vibrator motor operatively coupled to a skin vibrating element extending out of the housing. McGrath teaches a reservoir being adjacent to said vibrating element where "Means are provided for releasably mounting said fluid reservoir on said housing with said dispensing ball valves adjacent said skin vibrating element" (Column 1, lines 31-34).

Applicants respectfully suggest that the § 103(a) rejection based on McGrath and Kiefer evidences "picking and choosing" features of the references and combining them when there is no suggestion in those references to do so. It is impermissible within the framework of a 35 U.S.C. § 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art.

Specifically, the Examiner cites that "It would have been obvious to one of ordinary skill in the art to modify McGrath to configure the body contacting portion to emit heat as taught by Kiefer to provide the added benefit of heat therapy." Yet, Kiefer teaches the fluid outlet on the opposite side of the body from the aluminum plate. McGrath, in contrast, teaches the reservoir located adjacent to said vibrating element. The two references in fact teach differently in regards to the fluid reservoir's placement. Consequently, the Examiner provides no explanation as to how to add heat as taught by Kiefer to McGrath without ignoring Kiefer's teaching of the reservoir located on the opposite side to where the heat is applied. Therefore, the rejection based on the

combination of McGrath in view of Kiefer is respectfully traversed and accordingly, claims 14 and 15 are submitted to be allowable.

Claims 1 and 16-19 stand rejected under 35 U.S.C § 103(a) as being obvious over Sivan et al. in view of Kiefer et al. The arguments asserted above traversing the rejection based on Kiefer are reasserted here. Sivan teaches a cellulite massage system having a bottom surface, a means for producing suction to produce a massage action at the bottom surface and a built-in gel dispenser in the body for dispensing gel to the bottom surface. The invention teaches providing massage via vacuum therapy.

The Examiner cites that it "would have been obvious of one of ordinary skill in the art to modify Sivan to emit heat on the body contacting portion as taught by Kiefer to provide the added benefit of heat therapy." As stated above, Applicants respectfully suggest that the § 103(a) rejection based on Sivan and Kiefer evidences "picking and choosing" features of the references and combining them when there is no suggestion in those references to do so.

Specifically, Kiefer teaches an electro facial therapeutic device having an elongated main body with a long handle at one end and an opposite end having a bowl shaped aluminum plate with an electric coil behind the bowl connected to a transformer for heating up the bowl surface. The bottom surface of Sivan on the other hand does not contain an outwardly convex bowl made of aluminum as taught by Kiefer but rather contains a ridge (28) that enables the vacuum to be created between the suction bowl (18) and a user's body. The Examiner has not given any reason why one skilled in the art would

select an outwardly convex aluminum bowl shape as taught by Kiefer for combination with the bottom surface of Sivan. In addition, the outwardly convex aluminum bowl shape surface as taught by Kiefer is heated using an electric coil (14). The Examiner provides no explanation of how the heating coil and transformer used in Kiefer can fit within the restricted space of Sivan's housing as depicted in Figure 6.

Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. In fact, Sivan teaches away from using heat during massage. In the BACKGROUND OF THE INVENTION, Sivan acknowledges that applying heat with massaging had been known in the Prior Art as disclosed by U.S. Pat. No. 4,086,922 to Henderson which "relates to a method and apparatus for applying heat and a rolling massage pressure on the areas of the body having cellulite therein" (Column 1, lines 27-28). Consequently, the section concludes "This invention differs from the prior art in that a different technology is used to massage areas of the human body containing cellulite that satisfies a void in the market regarding issues of cellulite." Sivan teaches away from the use of heat during massage by claiming that vacuum therapy, in conjunction with gel, is filling a void in the market for treating cellulite, a market that already contains heated massagers. Teachings can be combined only if there is some suggestion or incentive to do so and that has not been shown by the Examiner. Therefore, the rejection based on the combination of the Sivan in view of Kiefer is respectfully traversed and accordingly, claim 1 is submitted to be allowable.

Further, regarding claim 18, the Examiner cites that Sivan "teaches a housing, a pump using motor 46 and removable reservoir 10 pivots to the refill position shown in figure 1 and pivotable cover 8." Claim 18 of the present invention recites, among other things, a reservoir being pivotably mounted to said massager between an operational position in which said reservoir is inclined relative to said body-contacting portion, and a refill position in which said body-contacting portion is placed in a generally vertical position and said reservoir is in a generally parallel position relative to said body-contacting portion. Sivan on the other hand only teaches that the cover (8) pivots to expose the gel tube (10). Neither Kiefer nor Sivan disclose the reservoir being pivotally mounted. Thus, Applicants' massager cannot be deduced by one skilled in the art when neither of the references before him teach this claimed feature. Therefore, the rejection of claim 18 based on the combination of Kiefer and Sivan is respectfully traversed. Accordingly, claim 18 is submitted to be allowable.

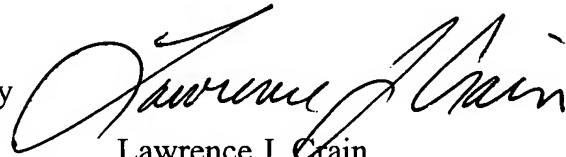
Applicants submit that in view of the above-identified amendments and remarks, the claims in their present form are patentably distinct over the art of record. Allowance of the rejected claims is respectfully requested. Should the Examiner discover

there are remaining issues which may be resolved by a telephone interview, an invitation is extended to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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